



# **FILING PROCEDURE OF INTELLECTUAL PROPERTY**

# Who can file a patent?



The application can be filed either alone or jointly by

## 1. The inventor

- By any person claiming to be true and first inventor(s)

## 2. Assignee of the inventor

- By any person being the assignee of person claiming to be true and first inventor(s)
- The natural person
- The legal entity (viz. company, university etc)
- ( proof of assignment has to be submitted along with the application)

3. By the **legal representative of any deceased person** or assignee: The legal representative of the deceased applicant

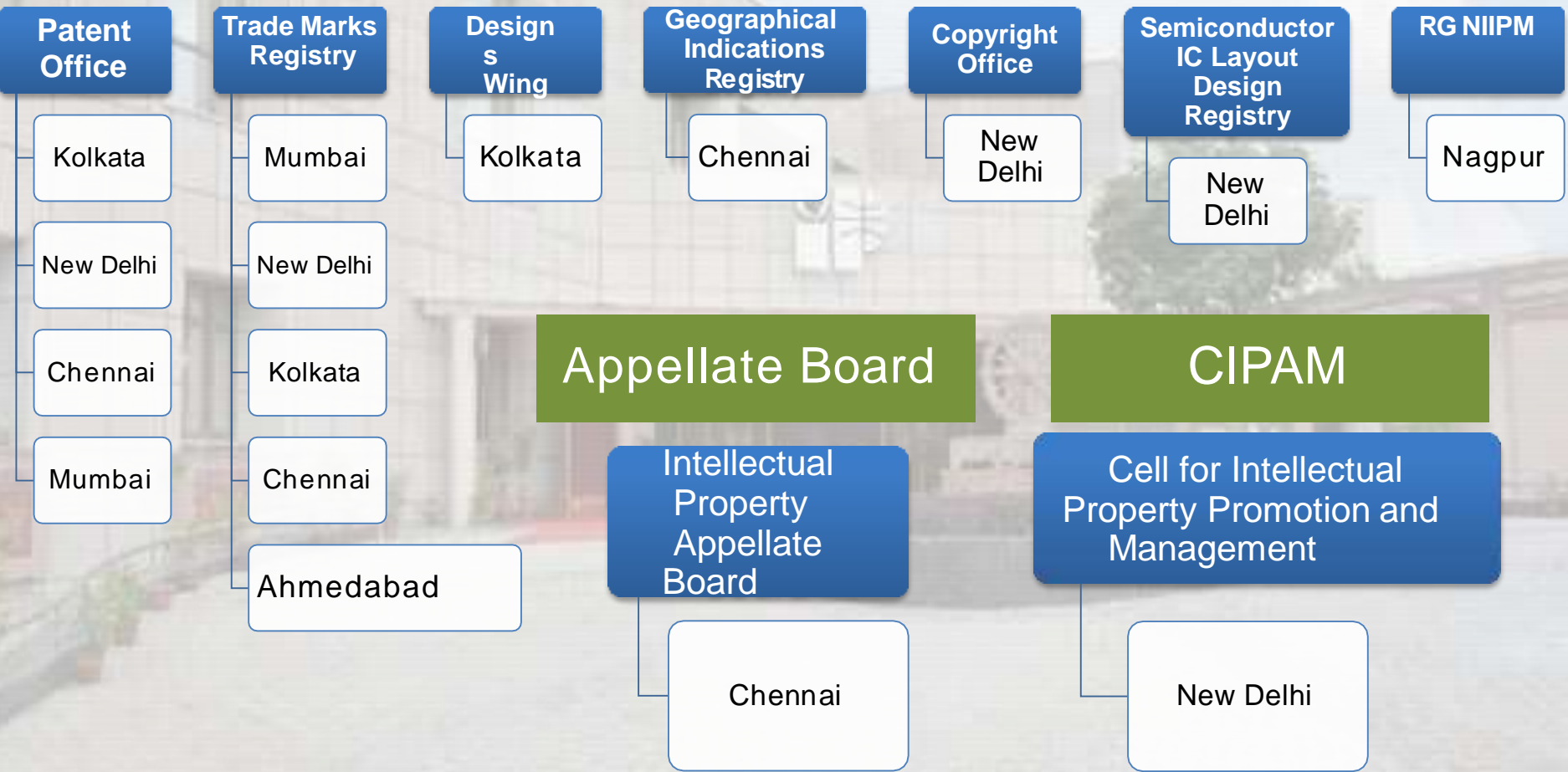
# Categories of applicants:

- Natural Person
- Startup
- Small Entity
- Large Entities

## JURISDICTION FOR FILING (RULE 4)

<b>Patent Office</b>	<b>Territorial Jurisdiction</b>
<b>Mumbai</b>	<b>-Maharashtra, Gujarat, Madhya Pradesh &amp; Goa. -Daman &amp; Diu, Dadra &amp; Nagar Haveli \ </b>
<b>Chennai</b>	<b>-Andhra Pradesh, Kerala, Tamil Nadu &amp; Karnataka. -Pondicherry, Laccadive, Minicoy and Aminidivi Islands.</b>
<b>New Delhi</b>	<b>-Delhi, Haryana, Himachal Pradesh, Jammu &amp; Kashmir, Punjab, Rajasthan &amp; Uttar Pradesh -Chandigarh</b>
<b>Kolkata</b>	<b>The Rest of India.</b>

# Controller General of Patents, Designs and Trade Marks



Offices

Before you start:

## PATENT SEARCH DATABASE

### Free Patent Databases

- Google Patents:  
<https://patents.google.com/>
- Espacenet:  
<https://worldwide.espacenet.com/>
- USPTO Web Patent Databases:  
<https://assignment.uspto.gov/patent/index.html#/patent/search>
- PQAI: <https://about.projectpq.ai/>
- Patentscope by WIPO:  
<https://patentscope.wipo.int/>
- Lens.org

### Paid Patent Databases

- Derwent World Patents Index:  
<https://clarivate.com/derwent/>
- PatBase: [www.patbase.com/](http://www.patbase.com/)
- Patseer: <http://patseer.com/>
- Drug Patent Watch:  
<https://www.drugpatentwatch.com>
- Patsnap: <https://www.patsnap.com>
- WIPO's INSPIRE: <https://ipportal.wipo.int/>

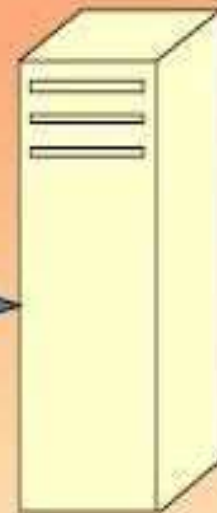


# Filing of the Application

**Physical filing at the Patent Office**



**Electronic filing  
(July 20, 2007)**







Office of the Controller General of Patents, Designs & Trade Marks  
Department of Industrial Policy & Promotion,  
Ministry of Commerce & Industry,  
Government of India

सत्यमेव जयते

# Patent E-filing



Patents ▾

Designs ▾

Trade Marks ▾

GI ▾

RGNIIPM ▾



- > Comprehensive E-Filing
- > Public Search
- > Dynamic Utilities

E-Gateways ▶

- > Journals
- > Annual Reports
- > Vacancy Announcement

Publication ▶

- > Acts & Rules
- > Manuals / Guidelines
- > Controller's Decision

Resources ▶

- > Patent Information System
- > Result Framework Document
- > Request Proposal (RFP)

About Us ▶

## News & Updates

Pause ||

28 Dec 2016

Public Notice RGNIIPM: Closure of Subscriber Advance Payment Account (293 KB)

12 Jan 2017

## Tenders & Notice

Pause ||

July 21, 2016

Quotation Notice for Annual  
Comprehensive Maintenance of UPS

**new**

## Events

Public Training at RGNIIPM  
DETAILS OF PUBLIC TRAINING PROGRAMS'  
AT RGNIIPM, NAGPUR, MAHARASHTRA  
FOR 2017



## Physical filing at patent office:

### Mode of Filing:

- By post/registered post/speed post with
- DD Physical filing at the office counter

### Mode of FEE Payment at counter:

- Cash
- Demand Draft
- UPI (BHIM)

# Documents required to file application:

- Aduly filled in ***Application Form 1*** (In duplicate)
- Information regarding foreign filing:Form-3 (Induplicate)
- ***Proof of right*** to apply (if the inventor is not applicant)
- ***Prescribed Fees*** as per First Schedule (in cash/Demand draft/BHIM)
- ***Patent Specification*** (PS or CS), form-2 (Induplicate)
- ***Declaration as to inventorship***, form 5 (Duplicate)
- ***Abstract***. (about 150 words)
- ***Drawings*** - if required.(Duplicate)
- ***Power of authority*** - if applicable. (Single copy)

# FILING REQUIREMENTS

- **FORM-1:** APPLICATION FORM
- **FORM-2:** PROVISIONAL OR COMPLETE SPECIFICATION
- **FORM-3:** STATEMENT OF FOREIGN FILING
- **FORM-18:** REQUEST FOR EXAMINATION
- **FORM-5:** DECLARATION AS TO INVENTORSHIP (IF REQ.)
- **FORM-9:** REQUEST FOR EARLY PUBLICATION (IF REQ.)
- **FORM-26:** POWER OF ATTORNEY ON STAMP PAPER(IF REQ.)
- **PROOF OF RIGHT TO APPLY (PARAGRAPH 9 OF FORM 1)**
- **CERTIFIED COPY OF CONVENTION APPLICATION, IF REQ.**

## OTHER DOCUMENTS IF REQUIRED

- **FORM-4:** REQUEST FOR EXTENSION OF TIME
- **FORM-6:** CHANGE IN APPLICANT
- **FORM-7:** NOTICE OF OPPOSITION (POST GRANT)
- **FORM-8:** MENTIONING THE NAME OF THE INVENTOR
- **FORM-10:** AMENDMENT OF PATENT (GRANTED TO DECEASED)
- **FORM-13:** AMENDMENT OF THE APPLICATION/SPECIFICATION
- **FORM-15:** RESTORATION OF PATENT
- **FORM-22:** REGISTRATION OF PATENT AGENT
- **FORM-25:** PERMISSION FOR MAKING PATENT APPLICATION  
OUTSIDE INDIA

**FORM 1**  
**THE PATENTS ACT 1970**  
**(39 OF 1970)**  
**&**  
**The Patents Rules, 2003**  
**APPLICATION FOR GRANT OF PATENT**  
**(See section 7,54 & 135 and rule 20 (1))**

**(FOR OFFICE USE ONLY)**

**Application No.:**

**Filing Date:**

**Amount of Fee Paid:**

**CBR No.:**

**Signature:**

**1. APPLICANT**

Name

Nationality

Address

**2. INVENTOR ( S )**

Name

Nationality

Address

**3. TITLE OF THE INVENTION**

**4. ADDRESS FOR CORRESPONDENCE OF APPLICANT / AUTHORIZED PATENT AGENT IN INDIA**

Telephone No. :

Fax No.

Mobile No.

E-mail :

**5. PRIORITY PARTICULARS OF THE APPLICATION (S) FILED IN CONVENTION COUNTRY**

Country

Application Number

Filing Date

Name of the Applicant

Title of the Invention

**6. PARTICULARS FOR FILING PATENT COOPERATION TREATY (PCT) NATIONAL PHASE**

**9. DECLARATIONS :**

**(i) Declaration by the Inventor (s)**

We, the above named inventor(s) are the true & first inventor(s) for this invention and declare that the applicant(s) herein is our assignee.

(a) Date

(b) Signature (s)

(c) Name(s)

**(ii) Declaration by the applicant (s) in the convention country**

I/We, the applicant(s) in the convention country declare that the applicant(s) herein is our assignee

(a) Date

(b) Signature (s) **N.A.**

(c) Name(s) of the signatory



**(iii) Declaration by the applicant (s):****I/We, the applicant(s) hereby declare(s) that:**

- o We are in possession of the above – mentioned invention.
- o The provisional/complete specification relating to the invention is filed with this application.
- o The invention as disclosed in the specification uses the biological material from India and the necessary permission from the competent authority shall be submitted by me/us before the grant of patent to me/us.
- o There is no lawful ground of objection to the grant of the Patent to me/us.
- o I am/We are the assignee or legal representative of true & first inventors.
- o The application or each of the applications, particulars of which are given in Para – 5 was first application in convention country/countries in respect of my/our invention.
- o I/We claim the priority from the above mentioned application(s) filed in convention country/countries and state that no application for protection in respect of the invention had been made in a convention country before that date by me/us or by any person from which I/We derive the title.
- o My/our application in India is based on international application under Patent Cooperation Treaty (PCT) as mentioned in Para – 6.
- o The application is divided out of my/our application particulars of which are given in Para – 7 and pray that this application may be treated as deemed to have been filed on \_\_\_\_\_ under sec. 16 of the Act.
- o The said invention is an improvement in or modification of the invention particulars of which are given in Para – 8

**10. Following are the attachments with the application:**

- (a) Complete specification.
  - (b) Complete specification (in conformation with the international application) / as amended before the International Preliminary Examination Authority (IPEA), as applicable (2 copies). No. of pages                      No. of claims
  - (c) Drawings (in conformation with the international application) / as amended before the International Preliminary Examination Authority (IPEA), as applicable (2 copies). No. of sheets
  - (a) Priority documents
  - (b) Translation of priority document / specification/ International Search Report
  - (c) Statement and undertaking on Form 3
  - (d) Power of Authority
  - (e) Declaration of inventorship on Form 5
  - (f) Sequence listing in electronic form (floppy disc)
  - (g).....
- Fee Rs. ....in Cash/Cheque/Bank Draft bearing no. ....
- Date ..... On ..... Bank.

I/We hereby declare that to the best of my/our knowledge, information and belief the fact and matters stated herein are correct and I/We request that a patent may be granted to me/us for the said invention.

Dated this                      day of September 2005.

Signature :-

Name :

# FORM 2

## THE PATENTS ACT, 1970

(39 of 1970)

### PROVISIONAL / COMPLETE SPECIFICATION

(See section 10 and rule 13)

1. TITLE OF THE INVENTION	
2. APPLICANT(S) (a)NAME (b)NATIONALITY (c)ADDRESS	
3. PREAMBLE TO THE DESCRIPTION	
<b>PROVISIONAL</b> The following specification describes invention	<b>COMPLETE</b> The following specification particularly describes the invention and the manner in which it is to be performed
4. DESCRIPTION (Description shall start from next page)	
5. CLAIMS (not applicable for provisional specification. Claims should start with the preamble – “I/We claim” on separate page)	
6. DATE AND SIGNATURE ( to be given on the last page of specification)	
7. ABSTRACT OF THE INVENTION (to be given along with complete specification on the separate page)	

**FORM 3**  
**THE PATENT ACT, 1970**  
**( 39 OF 1970 )**  
**&**  
**The Patents Rules, 2003**  
**STATEMENT AND UNDERTAKING UNDER SECTION 8**  
**( See section 8, rule 12 )**

We hereby declare

(i) that /We who have made this application No. \_\_\_\_\_ Dated \_\_\_\_\_ alone, made for the same/substantially same invention, application(s) for patent in the other countries, the particulars of which are given below :

Name of the country	Date of Application	Application No.	Status of the application	Date of publication	Date of grant
---------------------	---------------------	-----------------	---------------------------	---------------------	---------------

Not Applicable

(iii) that the rights in the application(s) have been assigned to us and that We undertake that upto the date of grant of the patent, by the Controller. We would keep him informed in writing the details regarding corresponding applications for patents filed outside India within three months from the date of filing of such application.

Dated this \_\_\_\_\_ day of September 2005

For

Signature

To,  
The Controller of Patent  
**The Patent Office, Mumbai**

**FORM 5**

**THE PATENT ACT, 1970  
( 39 OF 1970 )**

**&**

**The Patents Rules, 2003  
DECLARATION AS TO INVENTORSHIP  
[See section 10(6) and rule 13(6)]**

**1. NAME OF APPLICANT (S)**

hereby declare that the true and first inventor(s) of the invention disclosed in the complete specification filed in pursuance of my / our application numbered                      filed on                      are

**2. INVENTOR (S)**

**a.Name:**

**b.Address:**

**c.C. Nationality:**

Dated this  
Signature :-

**3. DECLARATION TO BE GIVEN WHEN THE APPLICATION IN INDIA IS FILED BY THE APPLICANT (S) IN THE CONVENTION COUNTRY:-**

Dated this 19<sup>th</sup> day of April 2005.  
Signature :-

To,  
The Controller of Patent  
The Patent Office, at Mumbai

# FEES FOR PATENT APPLICATION

## THE FIRST SCHEDULE: FEES

On what payable	For e-filing			For Physical Filing		
	For natural person(s) and or Startup	Small entity, alone or with natural person(s) and/ or Startup	Others, alone or with natural person(s) and/ or Startup and/ or small entity	For natural person(s)	Small entity, alone or with natural person(s) and/ or Startup	Others, alone or with natural person(s) and/ or Startup and/ or small entity
On application for a patent accompanied by provisional or complete specification (multiple for each priority)	1600	4000	8000	1750	4400	8800
(i) for each sheet of specification in addition to 30	160	400	800	180	440	880
(ii) for each claim in addition to 10	320	800	1600	350	880	1750

[http://ipindia.nic.in/ipr/patent/patent\\_FormsFees/Fees.pdf](http://ipindia.nic.in/ipr/patent/patent_FormsFees/Fees.pdf)



# Type of Patent Applications

1. Ordinary application (Sec. 9 & 10)
  - (i) application with provisional specification
  - (ii) application with complete specification
2. Convention application (Sec. 135)
3. PCT National Phase Application (Rule 20)
4. Divisional Application (Sec. 16)
5. Patent of Addition (Sec. 54)

# PATENT SPECIFICATION

➤ PROVISIONAL SPECIFICATION

➤ COMPLETE SPECIFICATION

# PATENT SPECIFICATION

## Provisional specification

- Secures ***priority date***
- May be filed as soon as the patentable idea comes in mind and ***discloses essential features*** of the invention
- Time limit to file Complete Specification after provisional Specification:
- **Twelve Months Benefits**
- Explore commercial feasibility, Avoid further expenses if no commercial feasibility
- NO RISK OF LOOSING PRIORITY LIBERTY TO DEVELOP
- DISCLOSE TO INTERESTED PERSON TO OBTAIN FINANCIAL SUPPORT

# COMPLETE SPECIFICATION

## *Page 1 (Cover Page): Form 2*

- Title of the invention, Name, address, nationality of applicant, preamble

## *Page 2 and onwards :*

- Field of invention
- Background of invention / prior art
- Advantages over prior art
- Summary of invention
- Statement of invention
- Detailed description of invention
- Working examples
- Followed by on fresh pages :
  - Claims,
  - Drawings (if any)
  - and accompany an abstract

**Note: PAGES EXCEEDING 30 INCLUDING DRAWING SHEETS AND CLAIMS EXCEEDING 10 ARE CHARGEABLE**

# REQUEST FOR EXAMINATION

- No Request → No Examination → No Patent
- Examination only on request within 48 month from priority date (Form 18)
- Request for examination. Examination Only after 11A publication
- No RQ for examination= application deemed to have been withdrawn
- Form 18- Request for Examination
- Form 18A- Expedited examination
  - Startup application
  - A application with ISA/IPEA India



# Patent Grant Procedure

Filing of patent application

Early Publication

Publication after 18 months

Opposition By Third Party  
Representation ( Pre Grant Opposition)

Request for examination

Examination: Grant or Refusal

Publication of Grant of patent

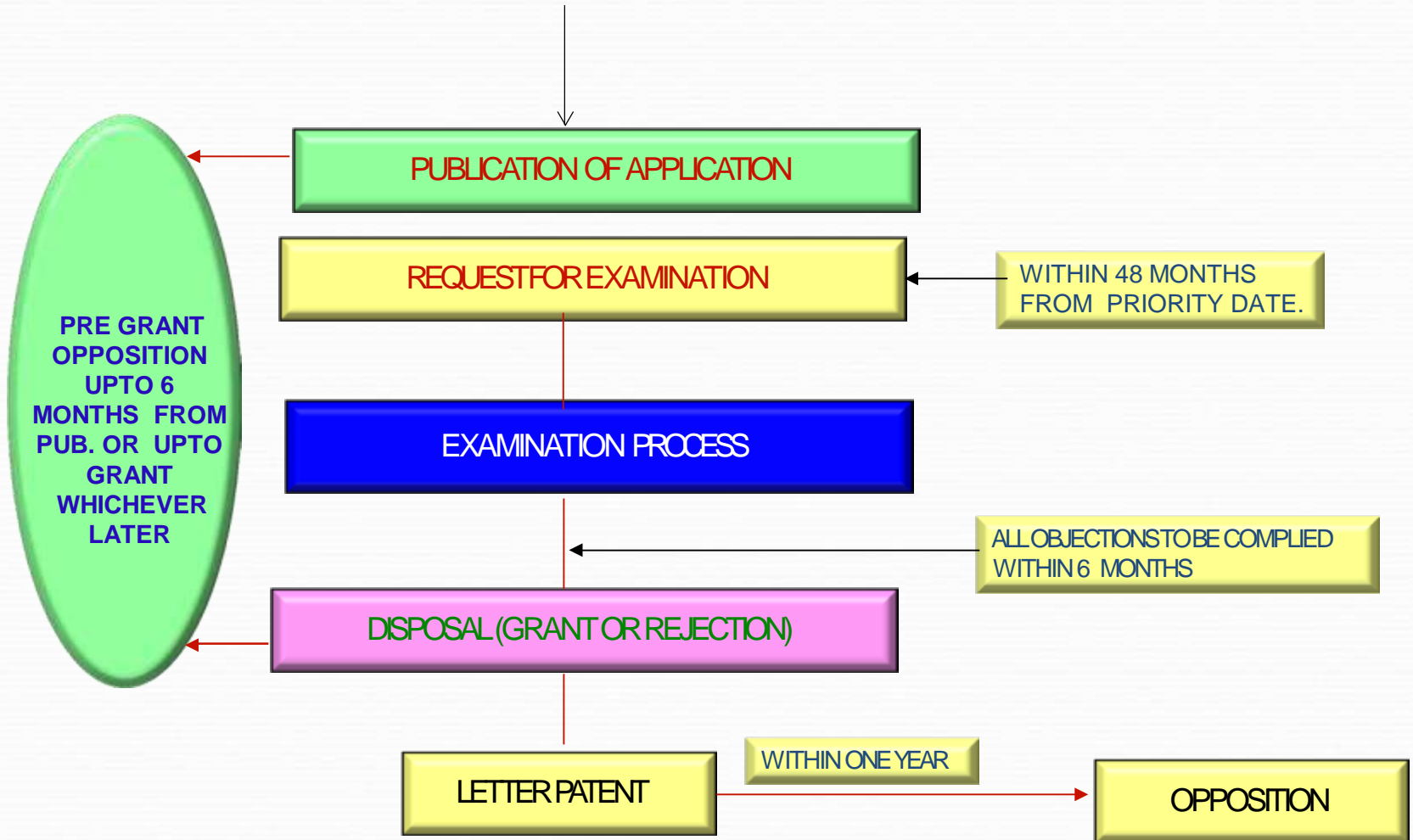
Opposition to the patent  
(Post Grant Opposition)

Decision By Controller

# STEPS FROM FILING TO GRANT OF PATENT

**FILING OF APPLICATION PROVNL. / COMPLETE**

AFTER 18 MONTHS FROM P.D OR IMMEDIATELY IF EARLY PUB. RQ. FILED.



# Types of opposition in India

## PRE GRANT OPPOSITION

- within 6 months from the date of 11A publication (18 Months)
- or before the grant of patent whichever is later

## POST GRANT OPPOSITION

- within 12 months from the date of publication of Grantu/s 43(2)

# PREGRANT OPPOSITION

Legality: Section 25(1)

- Defines the pre grant opposition
- Sets out the Grounds of opposition

“When an application for patent is published but the patent has not been granted, any person may, in writing, represent by way of opposition to the controller against the grant of patent”

## Grounds of opposition:

- Applicant has **wrongfully obtained** the invention
- **Prior publication**- The claimed invention is published prior to its priority date in
  - Any patent application filed in India on/after 01-01-1912
  - Any other document in India or elsewhere
- **Prior claiming**- The invention is claimed in an CS of application published after the priority date of the instant application but is filed prior to it.
- Invention was in **Prior public knowledge** or was in **prior public use** in India



## Grounds of opposition (cont.)...

- **Obvious**- The invention lacks any inventive step with regard to matter published or was used in India.
- **Non Patentable** – The subject matter of the invention is not an invention with regard to section 3, 4 of the Patents Act.
- **Insufficiency of description** – The CS does not sufficiently and clearly defines the invention or the method by which it is to be performed
- **Failure to disclose** the information regarding **corresponding foreign application** or furnishing false information u/s 8.

## Grounds of opposition (cont.)...

- **Failure to file convention application within 12 months** from the date of first application made in the convention country
- **Non-disclosure or wrongful mentioning** of the source and geographical origin of biological material used in the invention
- **Anticipation of invention by Traditional knowledge**, oral or otherwise available within any local or indigenous community in India or elsewhere

## Procedure:

- Rule 55
- An opponent shall file a representation to include
  - A statement of opposition
  - Evidence, if any
  - Request for hearing, if so desired
- No grant of patent before expiry of a period of six months from the date of 11A publication
- Consideration of representation only on filing of a request for examination by applicant
- If controller is of the opinion that application of patent shall be refused or requires amendment, he shall give Notice to applicant along with copy of representation

## Procedure: (Cont.)...

- Applicant shall, if he so desire, file a reply statement and evidence (if any) within three months from the date of notice
- On consideration of the statement and evidence, Controller may either refuse to grant the patent, or direct the CS to be amended to his satisfaction before granting the patent
- On Consideration of representation and submission during hearing, if so requested, and within 1 month from completion of above proceedings, controller may either
  - Reject the representation and grant the patent or
  - Accept the representation to refuse the grant the patent

## Postgrant opposition:

- Legality: Section 25(2)
  - Defines the post grant opposition
  - Sets out the Grounds of opposition
- Post grant opposition may be filed
- At any time before the expiry of one year from the date of publication of the grant of patent 43(2)
- By any interested person
- By giving a notice of opposition to the Controller
- On the prescribed grounds only
- No provision for extension of time to file notice of opposition

## Grounds of opposition:

- Applicant has **wrongfully obtained** the invention
- **Prior publication**- The claimed invention is published prior to its priority date in
  - Any patent application filed in India on/after 01-01-1912
  - Any other document in India or elsewhere
- **Prior claiming**- The invention is claimed in an CS of application published after the priority date of the instant application but is filed prior to it.
- Invention was in **Prior public knowledge** or was in **prior public use** in India

## Grounds of opposition (cont.)...

- **Obvious**- The invention lacks any inventive step with regard to matter published or was used in India.
- **Non Patentable** – The subject matter of the invention is not an invention with regard to section 3, 4 of the Patents Act.
- **Insufficiency of description** – The CS does not sufficiently and clearly defines the invention or the method by which it is to be performed
- **Failure to disclose** the information regarding **corresponding foreign application** or furnishing false information u/s 8.

## Grounds of opposition (cont.)...

- **Failure to file convention application within 12 months** from the date of first application made in the convention country
- **Non-disclosure or wrongful mentioning** of the source and geographical origin of biological material used in the invention
- **Anticipation of invention by Traditional knowledge**, oral or otherwise available within any local or indigenous community in India or elsewhere



## Procedure:

### **55A Filing of Notice of Opposition**

- Notice of opposition u/s 25(2) is to be filed in Form 7
- Prescribed Fee
- Controller shall notify the patentee.

### **56 Constitution of opposition board**

On receipt of opposition notice, Controller constitute an opposition board consisting of 3 examiners and one of them being the Chairman.

Examiner who dealt with the application for patent during the proceeding of grant shall not be a member of the board.

### **57 Filing of written statement**

- The opponent shall send a written statement setting out the nature of his interest, facts upon which he bases his case and relief which he seeks and evidences, if any, along with Form 7(Notice) with a copy to the patentee

### **58 Filing of Reply statement and evidence**

- If the patentee desires to contest the opposition, he shall file a reply statement setting out fully each ground of opposition and evidence, if any, in support of his case within 2 months from the receipt of opposition notice and evidences.

### **59 Filing of Reply evidence by opponent**

The opponent, within 1 month from the receipt of applicants reply statement file evidence strictly confined to the matters in the patentees evidence with a copy to the patentee

### **60 Further evidence**

No further evidence shall be delivered by either party except with the leave or direction of controller

# Procedure-opposition board:

- The board shall conduct the examination of the notice of opposition along with the documents filed.
- Board shall also examine the reply statement of the applicant along with any evidence, documents
- The board submits its joint recommendation to the controller within 3 months from the date on which such documents were forwarded to them.



**Best Wishes**